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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,271	07/19/2001	Thomas E. Creamer	BOC9-2000-0060(195)	2715
40987	7590	12/02/2004	EXAMINER	
AKERMAN SENTERFITT			ANWAH, OLISA	
P. O. BOX 3188			ART UNIT	
WEST PALM BEACH, FL 33402-3188			PAPER NUMBER	
			2645	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/910,271

**Applicant(s)**

CREAMER ET AL.

**Examiner**

Olisa Anwah

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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#### DETAILED ACTION

1. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Liversidge reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Claim 18, recites an electronic mail message comprising header information and a message portion. However Disclosure BOC8-2000-0053 fails to disclose the electronic mail comprises the claimed header information and a message portion.

Claim 4 recites the voice conference call list specifies telephone numbers for said identified conference call nodes. However Disclosure BOC8-2000-0053 does not teach the voice conference call list specifies telephone numbers for said identified conference call nodes.

Claim 7 claims, inserting a plurality of symbols. Nonetheless, Disclosure BOC8-2000-0053 fails to disclose inserting a plurality of symbols.

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Claim 8 indicates computer code is embedded in the email message. However Disclosure BOC8-2000-0053 does not teach computer code is embedded in the email message.

Claim 11 recites displaying a plurality of icons, but Disclosure BOC8-2000-0053 does not indicate displaying a plurality of icons.

2. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Liversidge reference to either a constructive reduction to practice or an actual reduction to practice because Applicant has failed to provide evidence of due diligence from June 8, 2000 through October 1, 2000 and January 2, 2001 through April 30, 2001.

Applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*,

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716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-37 are rejected under 35 U.S.C. § 102(e) as being anticipated by Liversidge et al, U.S. Patent Application Publication No. 2002/0076025 (hereinafter Liversidge).

Regarding claim 1, Liversidge discloses an email communication method comprising the steps of inserting in an email message a voice conference identifier comprising a voice conference call list identifying conference call nodes; transmitting said e-mail message to a recipient at a recipient node, wherein responsive to said recipient selecting said voice

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conference identifier, a voice conference call between selected ones of said identified conference call nodes is established (paragraphs 0134-0137 and 0181-0191).

Regarding claims 2 and 3, see paragraph 0183.

Regarding claims 4 and 5, see paragraph 0134.

Regarding claim 6, see paragraph 0137.

Regarding claims 7 and 8, see Figures 25 and 28.

Regarding claims 9, 10 and 12-16, see paragraphs 0136, 0137 and 0183.

Regarding claim 11, see Figure 25.

Regarding claim 17, see Figure 28.

Regarding claims 18, 20, and 23-25 see paragraphs 0134-0137 and 0181-0191.

Regarding claim 19, see Figures 25 and 28.

Regarding claims 21 and 22, see paragraph 0183.

Regarding claims 26 and 27, see Figures 25 and 28.

Regarding claims 28, 29, 31-33 and 37 see paragraphs 00136 and 00137. Also see paragraphs 0181-0191.

Regarding claim 30, see Figures 25 and 28.

Regarding claims 34 and 35 see paragraph 0183.

Regarding claim 36, see Figure 28.

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**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 703-305-4814. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

O.A.

Olisa Anwah  
Patent Examiner  
November 4, 2004

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
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